



11-07-06 IFW

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Patent
&
Trademark Law

November 6, 2006

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Attn: Art Unit 3653
Patent Examiner David Bollinger

Re: **Application No.:** 10/797,405
Confirmation No.: 5586
Applicants: Graef, et al.
Title: ATM Currency Dispenser With
Convex Roller Arrangement
Docket No.: D-1222 R4

Sir:

Please find enclosed Applicants' Response to the restriction requirement in the Office Action dated October 6, 2006 for filing in the above identified Application.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with this Response and any other fee due to Deposit Account 09-0428.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this document and the documents indicated as enclosed herewith are being deposited with the U.S. Postal Service as Express Mail Post Office to addressee in an envelope addressed to Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 this 6TH day of November, 2006.

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D-1222 R4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
Graef, et al.)	
)	
Application No.: 10/797,405)	Art Unit 3653
)	
Confirmation No.: 5586)	
)	
Filed: March 9, 2004)	Patent Examiner
)	David Bollinger
)	
Title: ATM Currency Dispenser With)	
Convex Roller Arrangement)	

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Reconsideration and withdrawal of the restriction requirement dated October 6, 2006 is respectfully requested. Kindly enter Applicants' remarks herein without prejudice as follows:

Applicants Provisionally Elect With Traverse

In response to the Office Action dated October 6, 2006 requiring restriction election, Applicants provisionally elect with traverse Group I (claims 1-18 and 20). Reconsideration and withdrawal of the restriction requirement is respectfully requested. As shown in more detail herein, the restriction requirement is without legal basis.

The Alleged Groups of Inventions

Claims 1-20 are pending. The Action alleges two distinct inventions:

- I. Claims 1-10, drawn to "an apparatus for dispensing media", classifiable in 271/10.01.
- II. Claim 19, drawn to "a method of dispensing media", classifiable in 271/34.

The Office Has Not Shown The Alleged Groups To Be Distinct

The Action relies on MPEP § 806.05(e) to allege that Groups II and I are related as process and apparatus for its practice.

MPEP § 806.05 states that "The burden is on the examiner to provide reasonable examples that recite material differences." Applicants respectfully submit that the Office has not met the prerequisite criteria for insisting on restriction requirement.

The restriction requirement is based solely on mere allegation. The Action provides no reason whatsoever why the Groups are allegedly distinct from each. Where does the Action provide any example (evidence) of a materially different apparatus by which the process may be practiced, as is required in order to sustain the restriction requirement? It doesn't. Nor does the Action explain how the Group II process of claim 19 can be practiced by a materially different apparatus when it depends on the Group I apparatus. Claim 19 depends on apparatus claim 13.

As the Office has not established that the process can it be practiced by a materially different apparatus, the reason provided for insisting on restriction is not valid. Therefore, Applicants respectfully submit that the restriction requirement should be withdrawn.

The Requirement is not legally proper because there is no serious burden

MPEP § 803 sets forth criteria for a proper restriction requirement. One of the criteria is that there must be a "serious burden" on the examiner in order for restriction to be required. Conversely, if the search and examination of an entire application can be made without serious burden, then the examiner must examine it on the merits. Applicants respectfully submit that the requirement is further not legally proper because the criteria for serious burden has not been met.

Rejoinder

The Action has not addressed the issue of rejoinder of claims (MPEP § 821.04). Thus, the Action is incomplete. Applicants respectfully submit that even if the claims were somehow directed to different Groups as alleged, that the process claim would still be entitled to rejoinder. Applicants reserve all rights to rejoinder.

The Restriction Requirement Is Without Legal Basis

Applicants also respectfully wish to point out that the Action fails to state a legally sufficient basis for imposing a restriction requirement. The Action indicates that the restriction requirement is solely based on a showing of the alleged inventions being "distinct." The statutory authority for the Office to impose a restriction requirement is found in 35 U.S.C. § 121. The statute expressly states that before the Office may require restriction, the inventions must be both "independent" and "distinct." The regulations that have been promulgated pursuant to this statute, 37 C.F.R. § 1.141 and 37 C.F.R. § 1.142, both expressly state that before a restriction requirement may be imposed the inventions claimed must be both independent and distinct.

Applicants respectfully disagree with the Office's interpretation of independent and distinct as set forth in MPEP § 802.01.

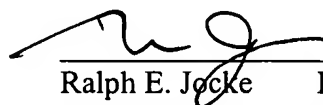
In the Action, there are only unsupported assertions that the sets of claims are “distinct.” There are no assertions that the sets of claims are “independent”, as is required. This standard does not comply with the statutory requirements. Therefore, the standard used in the Action for seeking to impose a restriction requirement is legally incorrect due to noncompliance with the clear wording of both the statute and the regulations promulgated thereunder. The application of such an incorrect legal standard is arbitrary, capricious, and contrary to law in violation of the Administrative Procedures Act.

Furthermore, the Office has acknowledged that before claimed inventions can be considered to be “independent” the inventions must be unconnected in design, operation, or effect. MPEP § 802.01. The Office has not established that all of the claims are not related in design, operation, and effect. Thus, the statutory requirements are not met and no restriction requirement may be imposed.

Conclusion

Applicants respectfully submit that the restriction requirement is not legally proper and should be withdrawn. The undersigned is willing to discuss any aspect of the application.

Respectfully submitted,



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